

REMARKS

Claims 1-21 remain in the application and have been rejected. Claims 1, 11, 12-13, and 15 have been amended. Applicant requests reconsideration of the rejections.

DRAWINGS

The Office Action objected to the drawings for having shading too dark for patent literature. Accordingly, FIG. 1 has been amended to remove the dark components and a replacement sheet and an annotated sheet showing changes are included.

OBJECTION TO THE CLAIMS

Dependent claims 12 and 13 are rejected for the informality of both being dependent on themselves. These claims have been amended to depend on claim 11. For this reason, the Applicant respectfully requests withdrawal of the Examiner's objection and allowance of these claims.

REJECTION UNDER 35 U.S.C. §101

The Office Action rejected claims 1-21 under 35 U.S.C. §101 for being directed to non-statutory subject matter. Specifically, the Office Action appears to contend that the invention claimed lacks a practical application. The Patent Statute provides: "Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this

title.” 35 U.S.C. §101. Excluded from patent protection are laws of nature, physical phenomena and abstract ideas.” *Diamond v. Diehr*, 450 U.S. 175, 185, 209 USPQ 1, 7 (1981). Claims 1-10 are directed to the category of patentable subject matter of processes (methods). None of the judicial exclusions from patentability apply. The Office Action finds that the claimed processes have no useful application. Applicant respectfully traverses this finding. Claims 1-10 claim methods for inserting probes in software programs. The probes provide information on the software. The useful result is that the information is used to improve performance of the computer in which the software runs. Claims 11 and 15 are respectively system and article of manufacture counterparts of claim 1 and provide the same useful result.

REJECTION UNDER 35 U.S.C. §102

The Office Action rejected claims 1-21 under 35 U.S.C. 102(e) as being anticipated by Morshed (US 6,721,941). The Applicant respectfully traverses the rejection and requests reconsideration in view of the amendment and the following remarks. Independent claims 1, 11, and 15 have been amended to recite the semantics about each probe as a *Markush* group. Morshed does not provide a selection from among the *Markush* group set forth and hence does not anticipate the claims. The dependent claims are not anticipated for at least the same reasons. Moreover, claim 12 is not anticipated by the admission in page 8 of the Office Action that Morshed does not teach a CDROM.

REJECTION UNDER 35 U.S.C. §103

In the Office Action, the Examiner rejected claim 12 under 35 U.S.C. 103(a) as being

unpatentable over Morshed in view of Berry (US 6,728,955). The Applicant respectfully traverses. A piecemeal reconstruction of the prior art patents in light of the Applicant's disclosure shall not be the basis for a holding of obviousness. *In re Kamm*, 172 USPQ 298 (CCPA 1972). Thus, it is impermissible within the framework of section 103 to pick and choose from any one reference only so much as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. *Kamm*, 172 USPQ at 302. Judge Markey has said: "virtually all inventions are 'combinations', and . . . every invention is formed of 'old elements' . . . Only God works from nothing. Man must work with old elements". H.T. Markey, *Why Not the Statute?*, 65 J. Pat. Off. Soc'y 331, 333-34 (1983). The rejection of claim 12 only shows that the CDROM element is an old element. That is not enough to show obviousness. Moreover, the reason that the Office Action gives for making the combination is that "CDROM drives are a simple way to distribute software." The simplicity of an invention is by no means a proof of obviousness.

REJECTION UNDER 35 U.S.C. §112

Claims 1-21 have been rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. Applicant respectfully traverses this rejection. The patent statute requires that an applicant provide a disclosure sufficient to enable one skilled in the pertinent art to make and use the invention. The enablement requirement is applicable only to the claimed invention. Nothing in the patent law requires that a patentee disclose data on how to mass produce the invented product. *Christianson v. Colt Industries Operating Corp.*, 822 F.2d 1544, 3 USPQ2d 1241 (Fed. Cir. 1987) (Colt was not required to include tolerances in his

application, which made parts interchangeable). A patent specification is also not required to be a production specification. *In re Gay*, 309 F.2d 769, USPQ 311 (CCPA 1962). Moreover, “[a] patent need not discuss what is well known in the art. *In re Wands*, 858 F.2d 731, 8 USPQ2d 1400 (Fed. Cir. 1988); *Spectra-Physics, Inc. v. Coherent*, 827 F.2d 1524, 3 USPQ2d 1737 (Fed. Cir. 1987) *cert. denied* 484 U.S. 954 (1987). First, the claimed invention does not require creating the probes. Rather, it requires providing a compiler with certain information including probes and semantics about the probes. The Office Action specifically finds that the terms “fast-path probe,” “guard swing” and “context hardness” are not enabled. The specification discusses an embodiment where different kinds of probes are inserted into a program. Given the disclosure, those skilled in the art would know how to insert the different kinds of probes. For example, at page 15 the specification discusses how to insert a probe into byte code.

In the case of “fast-path probe,” the Examiner reads “stating of dynamic conditions” into the claim and then states that this is not enabled. The Examiner has not shown that one skilled in the art would not be enabled to insert a “fast-path probe” into the program. Therefore the claim must be considered enabled.

In the case of semantics relating to the “guard swing,” paragraph [0033] of the specification discusses this type of probe. The Office Action does not show that those skilled in the art would not be enabled to insert these types of probes or to specify their semantics.

In the case of semantics relating to the “probe’s context hardness,” paragraph [0034] of the specification discusses this type of probe. The Office Action does not show that those skilled in the art would not be enabled to insert these types of probes or to specify their semantics.

For the foregoing reasons, Applicant respectfully requests entry of the amendment and allowance of the pending claims.

Respectfully submitted,

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Appl. No. 10/673,838
Annotated Sheet Showing Changes

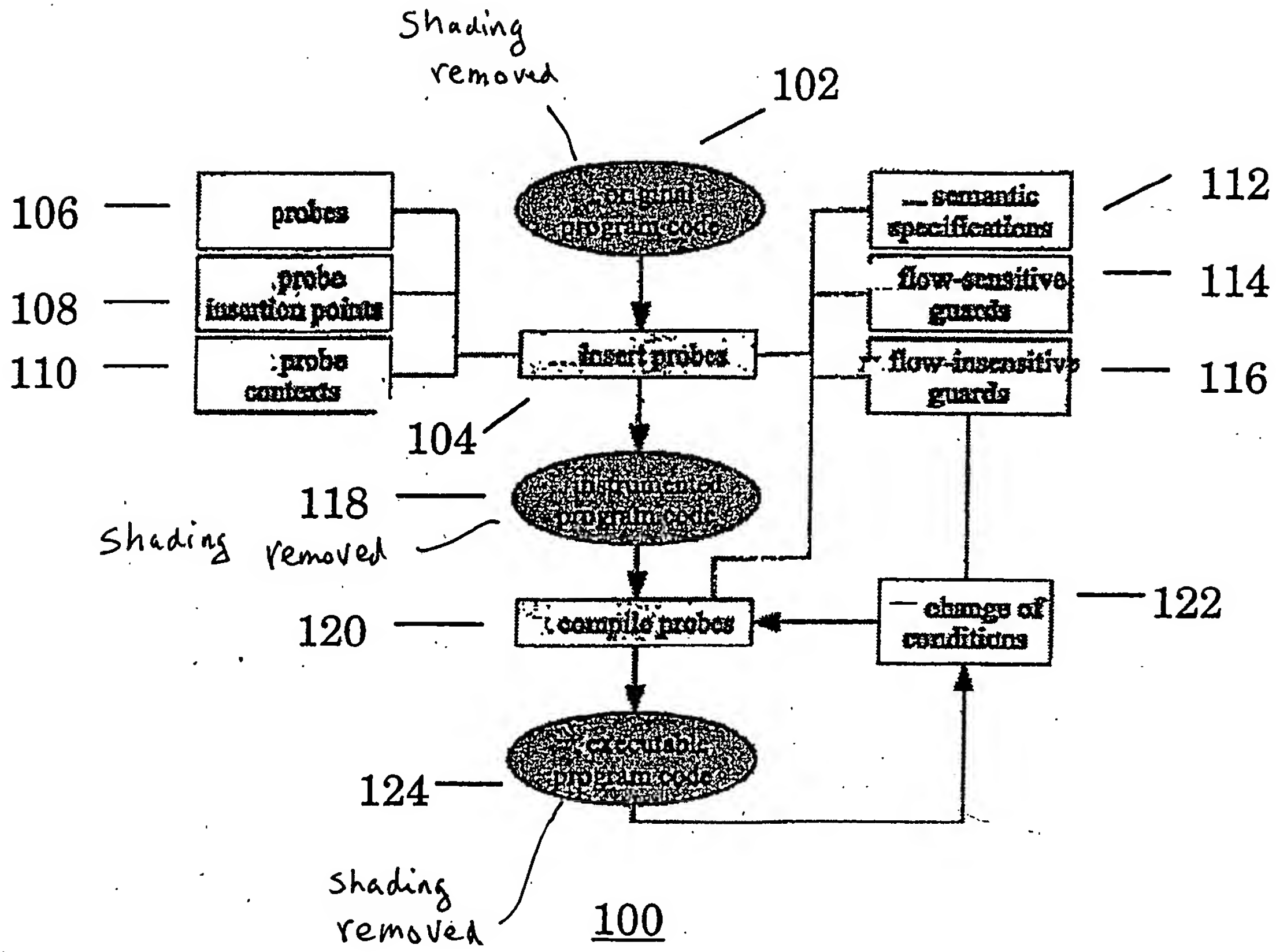


FIG. 1

Certificate of First Class Mailing

I hereby certify that this Amendment and Response to Office Action, and any documents referred to as attached therein are being mailed as First Class mail on this date, **September 19, 2006**, to the Commissioner for Patents, Mail Stop Amendment, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450.

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